



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,755	06/24/2003	Zhen Yu Yang	CL1459 USDIV	9985

23906 7590 02/07/2005

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1128
4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER

HU, HENRY S

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,755

Applicant(s)

YANG, ZHEN YU

Examiner

Henry S. Hu

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Pre-Amendment of 6-24-2003.
2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-17 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) _____ is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☒ Claim(s) 4-17 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. It is noted that Applicants' **Pre-Amendment** on claims filed on June 24, 2003 was received. **Claims 1-3 were canceled.** The application status on page 1 of specification is updated. **Claims 4-17 are pending now.** An action follows.

Election/Restrictions

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1, this is based on the preliminary search done by the examiner.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

I. **Claims 4-8 and 13-17**, drawn to a copolymer comprising repeating units of VDF and $\text{CH}_2=\text{CH}-(\text{CF}_2)_{2n}-\text{O}-\text{CF}_2\text{CF}_2-\text{SO}_2-\text{X}$, classified in class 526, subclass 247.

Art Unit: 1713

II. **Claims 9-12 and 13-17**, drawn to a different copolymer comprising repeating units of ethylene, tetrafluoroethylene and $\text{CH}_2=\text{CH}-(\text{CF}_2)_{2n}-\text{O}-\text{CF}_2\text{CF}_2-\text{SO}_2-\text{X}$, classified in class 526, subclass 248.

3. In the case Group I is elected, the Applicants need to further elect one of the following two species where **Claims 4-8 (Group I) are generic**:

Species (1) **X is $-\text{O}^-\text{M}^+$** with M is H^+ or an alkali metal cation

Species (2) **X is $-\text{N}^-(\text{M}^+)\text{SO}_2\text{R}_f$** with R_f being C1-4 perfluoroalkyl optionally substituted by one or more ether oxygen

In the case Group II is elected, the Applicants need to further elect one of the following two species where **Claims 9-12 (Group II) are generic**:

Species (1) **X is $-\text{F}$ or $-\text{O}^-\text{M}^+$** with M is H^+ or an alkali metal cation

Species (2) **X is $-\text{N}^-(\text{M}^+)\text{SO}_2\text{R}_f$** with R_f being C1-4 perfluoroalkyl optionally substituted by one or more ether oxygen

4. The inventions are distinct, each from the others because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different same functions, or different effects (MPEP § 806.04, MPEP § 808.01). Although the sulfonate-containing compounds may be useful as co-monomer in

Art Unit: 1713

making ionic copolymers, it can also be useful as a regular compound for chemical modification due to the existence of sulfonate functionality.

5. In the instant case, the copolymers made from Invention I and II, each of them may contain some repeating units from other invention. However, **the individual property of monomers will not be shown in its polymers mainly due to tremendous difference in molecular weight.** Although sulfonate functionality is used in both cases, **Invention I relates to a copolymer of VDF, while Invention II is restricted to use both ethylene and tetrafluoroethylene. Since they are two different copolymers which may be from different polymerization and with different properties, they are therefore different inventions.** As discussed earlier, a monomer may be used as a regular organic compound in addition to being used as a monomer for polymerization. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Where the group of inventions is claimed in one and the same international application, the requirement for unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one

Art Unit: 1713

or more of the same or corresponding special technical features. The expression “**special technical features**” shall mean those technical features that define a contribution which each of the claimed inventions considered as a whole, **makes over the prior art**. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, although they share the special technical feature, this special technical feature does not define a contribution over the prior art for the following reasons:

7. Claims 4-17 are either obvious or anticipated by any one of the following **WO 98/31716, US 5,672,438 and US 4,330,654**, each individually or in combination. **It should be noted that it may take totally different synthetic method to synthesize such a claimed compound even the difference is only on a small substituent.** In summary, these two types of polymers have no common features in the preparation as well as its application since they are structurally different. The scope of the claims, i.e., the metes and boundaries are distinct. Accordingly, the special technical feature linking the inventions, making copolymers comprising sulfonate-containing monomers from Group I or Group II does not provide a contribution over the prior art, and no single general inventive concept exists. Therefore the restriction is appropriate

8. Because these inventions are distinct for the reasons given above shown as different subject matters and the search required for each group is not required for other

Art Unit: 1713

groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, **Claims 4-8 (Group I) and Claims 9-12 (Group II) are generic.**

9. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. It is noted that no phone call was made to **John A. Langworthy (tel: 302 992-4362)** by the examiner due to the complexity in this particular case. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

12. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Henry S. Hu whose telephone number is (571) 272-1103. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306 for all regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Henry S. Hu

Examiner. Au 1713, USPTO

February 6, 2005


DAVID W. WU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700